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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,682	06/10/2005	Brian Douglas Chapman	DC5060 PCT 1	6929
137 7590 02/04/2008 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994			EXAMINER LOEWE, ROBERT S	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 02/04/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary

Application No.

10/538,682

Applicant(s)

CHAPMAN ET AL.

Examiner

Robert Loewe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's arguments/remarks, filed on 12/31/07, have been fully acknowledged.

Claim Objections

Claim 1 is objected to because formula (II) should contain a point of attachment to provide for clarity. Specifically, formula (II) should read " $-(Y_{3-n}R_nSiO_{1/2})_c(Y_{2-o}R_oSiO_{2/2})_d...$ "
Appropriate correction is required.

Claim 20 is presented twice and one must be deleted from the record. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, formula (II) of instant claim 1 contains a (CR_qY_{1-q}) group. It appears that the carbon atom in this group has only three bonds.
Appropriate correction is required.

Claim 4 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the limitation "x can range from 1 to 100" is vague and indefinite.

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The integer x **can** be from 1 to 100 but as written it does not have to be. It could be zero or a number greater than 100. Appropriate correction is required.

Claim 18 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 18, which is a composition claim, is dependent from claim 19, which is a product-by-process claim. For purposes of further examination, claim 18 will be interpreted as being dependent from instant claim 15. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 6, 8-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakayoshi et al. (US 2002/0099114).

Claim 1: Nakayoshi et al. teaches a method (examples of Nakayoshi et al.) comprising (1) heating (paragraph 0109) in the presence of a catalyst (paragraphs 0086-0088), a mixture comprising (i) at least one organohydrogensilicon compound which satisfies the structural limitations of formula (I) of instant claim 1 (top structure of paragraph 0076) and at least one compound having at least one aliphatic unsaturation (paragraphs 0059-0066) with (ii) at least one compound which satisfies the structural limitations of formula (IV) of instant claim 1 (bottom structure of paragraph 0092 for example), so as to cause polymerization of components (i) and (ii) to form silicon-bonded hydrogen containing branched polymers.

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It is noted in line 1 of instant claim 1 that "the presence of a catalyst" could also be the same platinum catalyst used to prepare the reaction product of component (i) of instant claim 1. As such, mixing all of the requisite starting materials of Nakayoshi et al. would inherently result in a reaction product of the starting materials used to prepare component (i) and further reaction products between component (i) and component (ii).

Claim 2: Nakayoshi et al. further teaches that b is an integer of 2 or 3 (paragraph 0076).

Claim 6: Nakayoshi et al. further teaches that R' is independently chosen from alkyl and alkenyl (paragraphs 0059-0066) and component (ii) is added between 3 and 1000 parts by weight based on 100 parts by weight of component (i) (paragraph 0025).

Claim 8: Nakayoshi et al. further teaches that the ratio of Si-H groups to Si-alkenyl groups can be less than 1 (paragraph 0085). Because of this teaching, it inherently follows that all of the Si-H groups would be consumed.

Claim 9: Nakayoshi et al. further teaches a branched polymer made by the method of claim 1 (paragraphs 0024-0027 and 0107).

Claim 10: Nakayoshi et al. further teaches a branched polymer of claim 10 (paragraphs 0024-0027 and 0107).

Claim 11: Nakayoshi et al. further teaches a composition comprising a branched polymer of claim 10, a Si-alkenyl crosslinker, a platinum-group containing catalyst (paragraphs 0024-0027 and 0107), and an inhibitor (paragraph 0097).

Claim 13: Nakayoshi et al. further teaches wherein the amount of catalyst is in the range of instant claim 13 (paragraph 0088).

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Response to Arguments

Applicant's arguments regarding claims 1, 2, 6, 8, 10, 12 and 13 (Nakayoshi et al. US 2002/0099114) have been fully considered but they are not persuasive.

Applicants argue that the scope of Nakayoshi et al. is very different from the instant application. Specifically, Applicant's argue that Nakayoshi et al. does not teach the endblocking materials of instant claim 1. It is believed, as described in the rejection above, that Nakayoshi et al. does indeed teach the addition of organopolysiloxanes which satisfy the structural limitations of formula (IV) of instant claim 1. It follows that these materials can inherently be used as endblocking materials. Further, Applicant's argue that the instant invention relies on an equilibrium type reaction between the SiH containing materials and the end-blockers resulting in a ring-opening reaction of the cyclic starting materials. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a ring-opening reaction of the endblocker) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, claim 1 is drawn to a method of heating in the presence of a catalyst, components (i) and (ii) (component (iii) is not considered since it is optional). Nakayoshi et al. teaches a method of heating in the presence of a catalyst, components (i) and (ii) which satisfy the structural limitations placed therein.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 9-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 and 8-13 of copending Application No. 10/538,680. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 1 and claim 1 of copending application '680 both claim a method of heating in the presence of a catalyst components (i), (ii), and optionally (iii). There is nothing claimed which distinguishes the two copending applications until claim 8 of the instant application which claims that an excess of aliphatically unsaturated component is required to consume all of the Si-H groups. Copending application '680 claims Si-H containing branched polymers, requiring a stoichiometric excess of Si-H groups to Si-alkenyl groups.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments regarding claims 1, 2, 6, 8, 10, 12 and 13 (Nakayoshi et al. US 2002/0099114) have been fully considered but they are not persuasive.

Applicants argue that the scope of Nakayoshi et al. is very different from the instant application. Specifically, Applicant's argue that Nakayoshi et al. does not teach the endblocking materials of instant claim 1. It is believed, as described in the rejection above, that Nakayoshi et al. does indeed teach the addition of organopolysiloxanes which satisfy the structural limitations of formula (IV) of instant claim 1. It follows that these materials can inherently be used as endblocking materials. Further, Applicant's argue that the instant invention relies on an equilibrium type reaction between the SiH containing materials and the end-blockers resulting in a ring-opening reaction of the cyclic starting materials. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a ring-opening reaction of the endblocker) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, claim 1 is drawn to a method of heating in the presence of a catalyst, components (i) and (ii) (component (iii) is not considered since it is optional). Nakayoshi et al. teaches a method of heating in the presence of a catalyst, components (i) and (ii) which satisfy the structural limitations placed therein.

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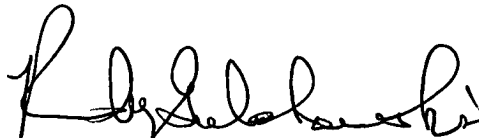
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSL
17-Jan-08


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